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Arturo A. Rodriguez

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SCIENTIFIC-ATLANTA, INC.
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EXAMINER

VAN HANDEL, MICHAEL P

ART UNIT

PAPER NUMBER

2623

NOTIFICATION DATE

DELIVERY MODE

05/21/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOmail@sciatl.com

Office Action Summary

Application No.

09/896,390

Applicant(s)

RODRIGUEZ ET AL.

Examiner

Michael Van Handel

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/23/2007 has been entered.

Response to Amendment

1. This action is responsive to an Amendment filed 2/23/2007. Claims **1-31** are pending. Claims **1, 4-6, 11, 14-17, 19-23, 25-27, and 29** are amended. Claims **32-57** are canceled. The examiner hereby withdraws the objections to claims **11, 15, and 16** in light of the amendment.

Response to Arguments

1. Applicant's arguments regarding claim **1**, filed 2/23/2007, have been fully considered, but they are not persuasive.

Regarding claim **1**, the applicant argues that Hassell et al. fails to disclose, teach, or suggest selecting without user intervention, a portable storage medium type corresponding to a media type of the first recordable media content, from the plurality of different portable storage medium types for storing the downloaded first recordable media content. The applicant specifically argues that Hassell et al. fails to teach or suggest a system having a plurality of

Art Unit: 2623

storage medium types. The applicant further specifically argues that Hassell et al. fails to disclose that there may be a plurality of secondary storage devices in the same system. The examiner respectfully disagrees.

Hassell et al. discloses a system with user television equipment that receives and stores video and data from television distribution facility 16 (Figs. 1-3). The user television equipment includes a digital storage device 31, 49 that may be a writable optical storage device (such as a DVD player capable of handling recordable DVD discs), a magnetic storage device (such as a disk drive or digital tape), or any other digital storage device. The user television equipment further includes a secondary storage device 32, 47 that can be any suitable type of analog or digital program storage device (e.g., a videocassette recorder, a DVD player with the ability to record DVD discs, etc.)(p. 2, paragraphs 19, 20 & p. 8, paragraphs 81, 84-90). Hassell et al. further discloses transferring the program between digital and analog devices, thereby indicating that the digital storage device 31, 49 and secondary storage device 32, 47 need not be the same storage media (p. 8, paragraphs 82, 83). Since Hassell et al. discloses utilizing different removable recording media to record video, and further discloses transferring video between the different removable recording media, the examiner maintains that Hassell et al. meets the limitation of "a storage device capable of storing on a plurality of portable storage medium of a plurality of different portable storage medium types," as currently claimed.

Further regarding claim 1, the applicant argues that Hassell et al. fails to disclose, teach, or suggest selecting without user intervention, a portable storage medium type corresponding to a media type of the first recordable media content, from the plurality of different portable storage medium types for storing the downloaded first recordable media content. The examiner

Art Unit: 2623

respectfully disagrees. The applicant specifically argues that merely determining the type of secondary storage device (for example, an analog videocassette recorder) and then recording content according to the limits of the device is simply not the same as selecting without user intervention, a portable storage medium type ... from the plurality of different portable storage medium types.

Hassell et al. discloses a program guide that allows a user to transfer programs and super-programs stored on digital storage device 49 to other volumes of digital storage device 49 or to secondary storage device 47 (p. 8, paragraphs 81-88). Hassell et al. further discloses that if the user indicates a desire to access a feature of the program guide, which operates on a medium that is not currently loaded in digital storage device 49, the program guide may automatically change the loaded storage medium if digital storage device 49 has the ability to do so. Digital storage device 49 may be, for example, an optical jukebox with multiple recordable optical discs. The jukebox can re-arrange the discs until the correct disc is positioned for writing (p. 8, paragraph 89). This meets the limitation of selecting "without user intervention, a portable storage medium type corresponding to a media type of the first recordable media content, from the plurality of different portable storage medium types for storing the downloaded first recordable media content," as currently claimed. In an alternative interpretative, the examiner notes that it is the program guide of Hassell et al. that stores programs and associated data on digital storage device 49 or secondary storage device 47 (p. 9. paragraphs 97, 98). That is, even if the user chooses a program and particular medium for recording, it is the program guide that implements the selecting and storing functions. Therefore, the examiner interprets the program guide as selecting the medium for storage without user intervention. This also meets the limitation of

Art Unit: 2623

selecting “without user intervention, a portable storage medium type corresponding to a media type of the first recordable media content, from the plurality of different portable storage medium types for storing the downloaded first recordable media content,” as currently claimed.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4-17, 19-25, 27, 29, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Hassell et al.

Referring to claims 1 and 17, Hassell et al. discloses a recordable media content archiving system in a subscriber network, said recordable media content archiving system comprising:

- a memory for storing recordable media content characterizing information (p. 1, paragraph 8 & p. 2, paragraphs 17, 18);
- a storage device capable of storing on a plurality of portable storage medium of a plurality of different portable storage medium types (p. 2, paragraphs 19, 20; p. 8, 9, paragraphs 86, 89, 90; & p. 9, paragraphs 97, 98); and
- a processor configured with the memory to:

Art Unit: 2623

- receive into the memory characterizing information corresponding to respective recordable media content (p. 1, paragraph 8 & p. 2, paragraphs 17, 18);
- provide a user interface with at least a portion of the received characterizing information, said portion corresponding to a first recordable media content (p. 1, paragraph 8; p. 3, paragraphs 27, 29; & p. 4, paragraph 37);
- download the first recordable content via the subscriber network from a server responsive to a first user input selecting the first recordable media content from the user interface (p. 4, paragraphs 41-42);
- select without user intervention, a portable storage medium type corresponding to a media type of the first recordable media content, from the plurality of different portable storage medium types for storing the downloaded first recordable media content (p. 4, paragraphs 43, 44; p. 5, paragraph 47; p. 8, paragraphs 81-87, 89, 90; p. 9, paragraphs 98, 99; & Fig. 17); and
- store on at least one of the plurality of portable storage medium types the downloaded first recordable media content, the at least one of the plurality of portable storage mediums corresponding to the media type of the first recordable media content (this limitation is met by the above cited paragraphs).

Referring to claim 4, Hassell et al. discloses the system of claim 1, wherein the processor is further configured to store recordable media content characterizing information corresponding

Art Unit: 2623

to the first recordable media content on the plurality of portable storage mediums corresponding to the media type of the first recordable media content (p. 8, paragraphs 82, 88 & Fig. 13).

Referring to claim 5, Hassell et al. discloses the system of claim 1, wherein the storing on the at least one of the plurality of portable storage mediums of the downloaded first recordable media content corresponds to an archiving operation (the examiner notes that the user can transfer programs stored on digital storage device 49 to other volumes of digital storage device 49 or to secondary storage device 47. The examiner interprets this functionality as being the equivalent of an archiving operation)(p. 8, paragraphs 81, 89).

Referring to claim 6, Hassell et al. discloses the system of claim 5, wherein an archive screen with pre-configured categories is presented to a user prior to storing the downloaded first recordable media content on the at least one of plurality of portable storage mediums (p. 4, paragraph 37; p. 5, paragraph 52; & p. 8, paragraphs 81, 82).

Referring to claim 7, Hassell et al. discloses the system of claim 6, wherein a default is presented to the user for a first pre-configured category (the examiner notes that pre-configured categories for M*A*S*H are comedy and war)(p. 4, paragraph 45 & Fig. 7b).

Referring to claim 8, Hassell et al. discloses the system of claim 7, wherein the first pre-configured category corresponds to genre (Fig. 7b).

Referring to claim 9, Hassell et al. discloses the system of claim 8, wherein the default presented to the user is a first genre associated with the downloaded first recordable media content (Fig. 7b).

Art Unit: 2623

Referring to claim 10, Hassell et al. discloses the system of claim 9, wherein the first genre is a portion of the received characterizing information corresponding to the first recordable media content (p. 3, paragraph 35).

Referring to claim 11, Hassell et al. discloses the system of claim 10, wherein a second genre is presented to the user that is different than the first genre (the user may edit the contents of a user category field 86)(p. 4, paragraph 45 & Fig. 7b).

Referring to claim 12, Hassell et al. discloses the system of claim 11, wherein the received characterizing information corresponding to the first recordable media content is modified to include the second genre (Fig. 7b).

Referring to claim 13, Hassell et al. discloses the system of claim 6, wherein the archive screen is configured to enable the user to edit the defaults for the pre-configured categories (p. 4, paragraph 45 & Fig. 7b).

Referring to claim 14, Hassell et al. discloses the system of claim 6, wherein a second archive screen is configured to enable the user to search for recordable media among the plurality of portable storage mediums on the storage device (p. 8, paragraphs 85-87 & Fig. 13).

Referring to claim 15, Hassell et al. discloses the system of claim 6, wherein the archive screen is configured to enable the user to search for characterizing information corresponding to the recordable media content among the plurality of portable storage mediums stored on the storage device (p. 8, 9, paragraphs 85-90 & Fig. 13).

Referring to claim 16, Hassell et al. discloses the system of claim 6, wherein the archive screen is configured to enable the user to create personalized categories (the user may edit the contents of a user category field 86)(p. 4, paragraph 45 & Fig. 7b).

Referring to claim **19**, Hassell et al. discloses the system of claim 1, wherein the processor is further configured to determine if the at least one of the proper plurality of portable storage mediums is loaded on the storage device (p. 4, paragraph 44; p. 5, paragraph 47; p. 8, paragraphs 81-83, 89).

Referring to claim **20**, Hassell et al. discloses the system of claim 19, wherein the processor is configured to automatically load the at least one of the proper plurality of portable storage mediums on the storage device (p. 8, paragraph 89).

Referring to claim **21**, Hassell et al. discloses the system of claim 20, wherein the at least one of the proper plurality of portable storage medium is categorized by title type (p. 8, paragraph 89).

Referring to claim **22**, Hassell et al. discloses the system of claims 21 and 32, wherein the processor is further configured to load the at least one of the proper plurality of portable storage mediums on the storage device with a title type corresponding to the first recordable media content (p. 8, paragraph 89).

Referring to claim **23**, Hassell et al. discloses the system of claim 1, wherein the processor is further configured to prompt the user to load the proper plurality of portable storage mediums on the storage device (p. 8, paragraph 89 & p. 10, paragraph 109).

Referring to claim **24**, Hassell et al. discloses the system of claim 1, wherein the processor is further configured to receive user input from a remote control device (p. 2, paragraph 19; p. 8, paragraph 85; & Fig. 2).

Referring to claim **25**, Hassell et al. discloses the system of claim 1, wherein the processor is further configured to categorize the first recordable media content and the plurality

Art Unit: 2623

of portable storage mediums by a user providing the first user input (p. 4, paragraph 45 & Fig. 7b).

Referring to claim **27**, Hassell et al. discloses the system of claim 1, wherein at least one of the recordable media content on the plurality of portable storage mediums located in the storage device have authorized access locks (p. 9, paragraphs 94, 99).

Referring to claim **29**, Hassell et al. discloses the system of claim 1, wherein the processor is further configured to enable a user to categorize recordable media content, and the plurality of portable storage mediums that store the recordable media content, into a structured archive, wherein the processor is further configured to receive the downloaded first recordable media content on at least one of the plurality of different portable storage medium types with characterizing information matching the downloaded first recordable media content (p. 4, paragraph 45 & Fig. 7b).

Referring to claim **30**, Hassell et al. discloses the system of claim 1, wherein the processor, the memory, and the storage device are located in a set top box (p. 2, paragraph 19).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims **2**, **18**, and **26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell et al. in view of LaJoie et al.

Art Unit: 2623

Referring to claims 2 and 26, Hassell et al. discloses the system of claims 1 and 25, respectively, wherein the first user input corresponds to a desire for personal possession of the first recordable media content (p. 4, paragraphs 41-42). Hassell et al. does not disclose that the first user input corresponds to a purchase. LaJoie et al. discloses a user input for purchasing an Impulse Pay-Per-View (IPPV) event for recording (col. 21, l. 42-49). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Hassell et al. to include a user input for purchasing an event for recording, such as that taught by LaJoie et al. in order to provide a full service television system capable of delivery advanced television services (LaJoie et al. col. 1, l. 43-45).

Referring to claim 18, Hassell et al. discloses the system of claim 1. Hassell et al. does not disclose that the processor is configured to receive the downloaded first recordable media content from the server through an exclusive network session. LaJoie et al. discloses transmitting programs to a subscriber's set-top terminal in the form of a unicast (unicast is the sending of information packets to a single destination (see <http://www.dictionary.com> encyclopedia definition of unicast)) transmission (col. 9, l. 43-52). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Hassell et al. to include transmitting programs to a subscriber in the form of a unicast transmission, such as that taught by LaJoie et al. in order to allow the user to access the content as quickly as possible.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell et al. in view of LaJoie et al. and further in view of Lewis.

Referring to claim 3, the combination of Hassell et al. and LaJoie et al. teaches the system of claim 2. The combination of Hassell et al. and LaJoie et al. does not teach that the recordable media content characterizing information is received into memory periodically. Lewis discloses a local Audio/Video Processor Recorder-player (VPR/DMS) unit that interfaces with an Account-Transaction Server (ATS) to establish a two-way communication with a broadcaster/content provider and updates itself at regular intervals, providing the home user with the latest available rental/purchase information (p. 20, paragraph 203). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the combination of Hassell et al. and LaJoie et al. to include updating rental/purchase information at regular intervals, such as that taught by Lewis in order to conserve bandwidth.

5. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell et al. in view of Browne et al.

Referring to claim 28, Hassell et al. discloses the system of claim 27. Hassell et al. does not disclose that the authorized access locks have corresponding icons displayed on one of a plurality of screen displays to alert the user to a requirement for authorized access. Browne et al. discloses the use of icons to alert the user of access locks (Fig. 6). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the parental control features of Hassell et al. to include icons to alert the user of control features, such as that taught by Browne et al. in order to provide a more user-friendly interface.

Art Unit: 2623

6. Claims **31** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell et al. in view of Russo.

Referring to claim **31**, Hassell et al. discloses the system of claim 1. Hassell et al. does not disclose that the processor, the memory, and the storage device are located in a headend. Russo discloses storing selected program materials in a program storage unit 14, wherein the storage technique employed includes recording data compressed information on arrays of disks or magnetic tapes, including auto-changer facilities to switching between media (col. 4, l. 10-21). Russo further discloses that the program storage unit 14 can be located at either the subscriber site or could be part of a larger storage unit located at the cable transmission facility (col. 4, l. 28-44). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Hassell et al. to include a program storage unit 14 at the transmission facility, such as that taught by Russo in order to reduce the cost of a user's set top box.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571-272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MVH


SCOTT E. BELIVEAU
PRIMARY PATENT EXAMINER